

Applicants : Jason Francis Conaty et al.
Serial No. : 09/887,880
Filed : June 22, 2001
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REMARKS

Claims 1-36 were pending in the subject application. Applicants have by this Amendment amended claims 21 and 31, and cancelled claims 25-30 without prejudice. Accordingly, claims 1-24 and 31-36 are presented for the Examiner's reconsideration. Of these, claim 1-20, 23 and 32-36 were indicated as being allowable in the August 27, 2003 final Office Action. The Amendment of claims 21 and 31 merely makes claims 21 and 31, and claims 22 and 24 dependent on claim 21, recite subject matter which the Examiner considers to be enabled by applicants' specification. Accordingly all of the now pending claims, i.e. claims 1-24 and 31-36, are in condition for allowance.

Rejection under 35 U.S.C. § 112, first paragraph

In Section 3 of the August 27, 2003 final Office Action, the Examiner rejected claims 21-22, and 24-31 under 35 U.S.C. §112, first paragraph, alleging that the specification, while being enabling for using the compounds of the present invention to cleave RNA *in vitro*, does not reasonably provide enablement for using the claimed compounds *in vivo*, to cleave RNA for treatment purposes. The Examiner alleged that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The Examiner acknowledged that the specification as filed provides guidance for transforming a host cell *in vitro* with the compounds of the present invention.

In response, without conceding the correctness of the Examiner's position, but merely to advance prosecution, applicants have cancelled claims 25-30 without prejudice, and amended claims 21 and 31 so that claims 21, 22, 24 and 31 recite subject matter

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which the Examiner has acknowledged is enabled by applicants' specification.

Accordingly, applicants respectfully submit that the rejection under 37 C.F.R. § 112, first paragraph, should be reconsidered and withdrawn.

In conclusion, applicants respectfully submit that because claims 1-20, 23 and 32-36 have been indicated to be allowable and claims 21, 22, 24 and 31, as amended, recite enabled subject matter and are free of the sole rejection in the August 27, 2003 Office Action, all pending claims are now in condition for allowance.

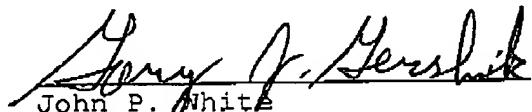
However, for the record, applicants maintain that there were many examples in the prior art before applicants' filing date, including human clinical trials, of treatment of animals with ribozymes of the type claimed by applicants in this application.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone at the number provided below.

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No fee is deemed necessary in connection with the filing of this Amendment. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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